

REMARKS

This responds to the Office Action mailed on September 25, 2006.

Claims 6 and 7 are amended, no claims are canceled, and claim 25 has been added. Claims 1-5 and 10-24 have been withdrawn; as a result, claims 1-25 are pending in this application.

Claim Amendments and Additions

The amendments and additions to the claims are fully supported by the specification as originally filed, and no new matter will be added by entry of the amendment. The amendments to the claims are made to satisfy Applicant's preferences, not necessarily to satisfy any legal requirement(s) of the patent laws. The amendments clarify the claims and are not intended to limit the scope of equivalents to which any claim element may be entitled. Applicant respectfully requests reconsideration of the above-identified application in view of the amendments above and the remarks that follow.

Claim 6 has been amended to add: "a pharmaceutical solution stream ejected from a thermal fluid ejection device, the pharmaceutical solution stream comprising:" and to add: "substantially evaporate from a substrate when deposited thereon." Further, claim 6 has been amended to delete: "with predetermined properties" and "wherein the vehicle substantially evaporates from the substrate."

Claim 7 has been amended to replace "predetermined" with "specific" and has been amended to add: "the component including a low toxicity Class 3 Solvent as listed in ICH Topic Q3C Impurities." Further, claim 7 has been amended to delete the phrase: "wherein the active pharmaceutical ingredient has a solubility of at least about 30 mg/ml in the vehicle."

Claim 25 has been added to recite: "The solution of claim 7 including a fluid viscosity in a range of about 1.15 cps to about 1.44 cps and including a fluid surface tension in a range of about 39 to 49 dynes/cm."

Support for these amendments may be found in the original specification, for example, in the paragraph beginning at page 7, line 12, on page 8, lines 5-11, and in the paragraph beginning at page 8, line 20 of the present application. In particular, the Class 3 Solvents are listed in a

report by the Food and Drug Administration. The list may be found at <http://www.fda.gov/cber/gdlns/ichq3ctablist.pdf>, referred to in the paragraph beginning on page 8, line 20 of the original specification. Further, the Class 3 solvents have a low toxic potential as discussed in more detail by a report from the Food and Drug Administration at <http://www.fda.gov/cber/gdlns/q3cresolvent.pdf>.

§112 Rejection of the Claims

Claims 6-9 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6 and 7 have been amended to more clearly claim the present subject matter. Accordingly, Applicant respectfully requests that the Office reconsider and withdraw the rejection of these claims under 35 U.S.C. § 112.

§103 Rejection of the Claims

Claims 6-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Patel et al. (U.S. Patent No. 6,294,192). Claims 6-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gardella et al. (U.S. Patent No. 4,002,718) in view of Patel et al. (U.S. Patent No. 6,294,192). Applicant respectfully traverses these rejections.

The Examiner has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988).

The M.P.E.P. states that:

“In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed.Cir. 1991).” *M.P.E.P.* §2142. (emphasis added.)

Even if combined, the cited references fail to recite all of the elements of Applicant’s claims

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness, because Patel, and Patel and Gardella fail to recite all of the elements of Applicant's claims. M.P.E.P. §2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

Neither Patel nor Gardella teaches "a pharmaceutical solution stream ejected from a thermal fluid ejection device" as recited in claim 6.

Because neither Patel nor Gardella teaches each and every claim element of independent claim 6, Applicant respectfully submits that claim 6 is not rendered obvious by these references, neither in combination nor alone. Accordingly, independent claim 6 is patentable over the cited references, and Applicant respectfully requests that the rejection be withdrawn.

Applicant respectfully requests reconsideration of the independent claim 6 and all rejected claims which depend from the allowable independent claim.

Claims 7-9, and 25 each depend from independent claim 6 and incorporate all of the limitations therein, respectively. Claims 7-9 and 25 are also asserted to be allowable for the reasons presented above, and Applicant respectfully requests notification of same. Applicant considers additional elements of claims 7-9 and 25 to further distinguish over Patel and Gardella, and Applicant reserves the right to present arguments to this effect at a later date.

Applicant believes the proposed new and amended claims are patentable, and that the amendments and additions made herein are within the scope of a search properly conducted under the provisions of MPEP 904.02. Accordingly, Applicant submits that claims 6-9 and 25 are patentable.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (707) 620-0369 (California) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 08-2025.

Respectfully submitted,

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12/19/06

By


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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 19th day of December 2006.

Name

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